

Amendment

Serial No. 09/778,234

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REMARKS/ARGUMENTS**Claim Objections**

The Examiner stated: "Claim is objected to because of the following informalities: line 9 has a typographical error, the recited "UNPROTECTED_BLOCK" should be recited as "UNPROTECTED_BLOCK". Appropriate correction is required."

The Examiner failed to specify the claim containing the typographical error. Applicant found it at Claim 1bi. However, Applicants discovered that "UNPROTECTED_BLOCK" and "PROTECTED_BLOCK" had been inadvertently interchanged in Claim 1b and made appropriate correction. Support for this amendment can be found at page 7, lines 10-15 and page 8, lines 3-24. No new matter has been added

Claim Rejections -35 USC § 112

The Examiner stated: "Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation 'said playback means' in lines 16 - 17. There is insufficient antecedent basis for this limitation in the claim because the claim language prior to lines 16 - 17 recites 'special playback means'."

Applicants have added the word "special" at this location thus providing proper antecedent basis.

The Examiner stated: "Claim 1 lines 3 - 4 recites '...and a block including said content, and said advertising embedded in each other'. This claim language is indefinite because it is not clear if the advertising is embedded with the content or if the advertising is embedded with other advertising i.e. each other."

Applicants have amended this wording to recite "... and said advertising embedded in said content..." This construction finds support at page 7, lines 14-15. No new matter has been

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added.

The Examiner stated: "Claim 10 recites the limitation 'said playback device' in line 5. There is insufficient antecedent basis for this limitation in the claim because the claim language prior to line 5 recites 'special playback device'."

Applicants have deleted the word "special" at two locations from this claim thus providing proper antecedent basis.

The Examiner stated: "Claim 10 lines 5-6 recites the limitation 'UNPROTECTED_BLOCK including said content, and said advertising embedded in each other.' This claim language is indefinite because it is not clear if the advertising is embedded with the content or if the advertising is embedded with other advertising i.e. each other."

Applicants have amended this wording to recite "... and said advertising embedded in said content..." This construction finds support at page 7, lines 14-15. No new matter has been added.

The Examiner stated: "Claim 10 is a method claim comprising steps. The claim first recites in lines 9-14 (step b) a playback device with two steps designed to i. Separate said advertising and ii. Playback said UNPROTECTED_BLOCK. Step c, the next step in the method recites distributing said file to playback device. These steps seem to be out of order since the file must be transmitted to the playback device before the steps of separation or playback can be performed."

The Applicants respectfully submit that the Examiner's analysis is not correct. Sub claims b1 and b2 are not steps in a method: they do not begin with a participle. They are limitations on the playback device. They are grammatically connected to the playback device by the phrase "designed to". Thus claim 10b comprises the step of "providing a playback device" which is "designed to" perform in certain specified ways. Therefore, Applicants respectfully submit that this claim is correct as written.

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The Examiner stated: "Claims 2 - 9 and 11 - 20 are rejected for being dependent on a rejected base claim."

Applicants submit that the above amendments and arguments render claims 1 and 10 allowable. Consequently, claims 2-9 and 11-20 are also now allowable.

Claim 10 is a method claim and claims 11-20 depend from claim 10. However, the preambles of claims 13-20 reference a "system". Applicants therefore have changed the word "system" to "method" in claims 13-20.

Conclusion

The Examiner stated: "The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Eldering et al (6,704930) — Advertisement insertion techniques

Rosser (6,446,261) — Targeted electronic insertion of Indicia

Eyer et al (6,588,015) — Broadcast interactive digital radio"

Applicants have considered this prior art and do not believe it affects the patentability of their invention.

Reconsideration of this application and its early allowance are respectfully requested in view of the above presented amendments and remarks.

Respectfully submitted,



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